

REMARKS

In the Office Action dated August 4, 2006, claims 26 and 27 were rejected under 35 U.S.C. § 101; claims 1, 3, 4, and 11 were rejected under § 103 over U.S. Patent No. 6,618,499 (Kohler) in view of U.S. Patent No. 6,344,853 (Knight); claims 5-8 and 10 were rejected under § 103 over Kohler in view of Knight and U.S. Patent No. 5,751,829 (Ringland); claim 9 was rejected under § 103 over Kohler in view of Knight and U.S. Patent No. 5,528,703 (Lee); claims 12 and 13 were rejected under § 103 over Kohler in view of Knight and U.S. Patent No. 5,506,946 (Bar); claims 14, 19, 20, and 28 were rejected under § 103 over Kohler in view of Ringland; claim 18 was rejected under § 103 over Kohler in view of Ringland and Lee; claims 22 and 23 were rejected under § 103 over Kohler in view of Knight, Ringland, and U.S. Patent No. 5,594,807 (Liu); claim 24 was rejected under § 103 over Kohler in view of Ringland and Liu; claim 26 was rejected under § 103 over Kohler in view of Lee; claim 27 was rejected under § 103 over Kohler in view of Lee and Knight; claim 29 was rejected under § 103 over Kohler in view of Ringland and Knight; claim 32 was rejected under § 103 over Kohler in view of Ringland and Liu.

REJECTION UNDER 35 U.S.C. § 101

Claim 26 has been amended to address the § 101 rejection.

REJECTIONS UNDER 35 U.S.C. § 103

CLAIM 1

Claim 1 was rejected as being obvious over Kohler and Knight. The Office Action conceded that Kohler does not disclose sending the identity of the corresponding color to a shopping website for purchasing a product having the corresponding color. 8/4/2006 Office Action at 8. However, the Office Action stated that Knight discloses this claimed feature. *Id.* It is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness for at least the following reasons: (1) no motivation or suggestion existed to combine the teachings of Kohler and Knight; and (2) the hypothetical combination of the references does not teach or suggest all elements of the claim. *See* M.P.E.P. § 2143 (8th ed., Rev. 5), at 2100-126.

As specifically held by the Federal Circuit, “[t]he PTO has the burden under section 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The PTO “can satisfy this burden only by showing *some objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine *the relevant teachings* of the references.” *Id.* Thus, as emphasized by the Federal Circuit, a basis for combining reference teachings is the teachings of the references themselves. In the previous Reply to Office Actions, Applicant has pointed to the specific teachings of the references (Kohler and Knight) and provided an explanation of why a person of ordinary skill in the art would not have been motivated to combine the reference teachings.

In response to such arguments, the Office Action asserted that “Applicant is respectfully reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” 8/4/2006 Office Action at 2. It is respectfully submitted that this mischaracterizes the arguments presented by Applicant. To show why a person of ordinary skill in the art would not have been motivated to combine the teachings of Kohler and Knight, and to show why the hypothetical combination of Kohler and Knight does not teach or suggest all elements of the claim, Applicant necessarily has to point to the teachings of the individual references. As held by *In re Fine*, the PTO can satisfy its burden of establishing a *prima facie* case of obviousness “only by showing some objective teaching in the prior art” or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine “the relevant teachings” of the references. Thus, the “relevant teachings” of the references are an important factor in considering whether a person of ordinary skill in the art would have been motivated to combine the reference teachings.

Kohler describes a technique that purportedly addresses the issue of different color output devices operating in respective different ranges of colors. Kohler, 1:21-23. A color that lies within a multi-dimensional color space for a first device may be outside the multi-dimensional color space for a second device. Kohler, 1:40-43. Consequently, such a color can be output by the first device, but cannot be output by the second device. Kohler, 1:43-45. Kohler describes a technique in which a color that lies outside the multi-dimensional color space of the second device can be mapped to a color point within the multi-dimensional color space of the second

device. Kohler, 5:30-36; 9:63-10:7. Once mapped, the color can then be provided to the second device, such as a printer, for output (printing). Kohler, 13:5-10.

An output device, such as a printer, can be located over a local area network or the worldwide web. Kohler, 4:61-64. In other words, according to Kohler, once a color is mapped to be within the color space of a particular output device, that color can be provided to such output device (which could be over a network) for output. What Kohler suggests to a person of ordinary skill in the art is that mapping of a color between different color spaces is performed so that such color can be output by a particular output device. It is important to note that there is absolutely no suggestion whatsoever in Kohler of any desirability to send the mapped color to a shopping website, as recited in claim 1.

In attempting to remedy this shortcoming of Kohler with respect to the claimed subject matter, the Office Action attempted to rely upon Knight as providing the requisite suggestion or motivation to modify Kohler to achieve the claimed subject matter. However, Knight clearly does not provide such suggestion or motivation. The Office Action relied specifically on the passage in column 10, lines 13-20, of Knight as disclosing the sending of the identity of a color over a network to a shopping website for purchasing a product having the corresponding color. 8/4/2006 Office Action at 8.

The cited passages of Knight describe a purchaser selecting from among available colors for a selected product. This selection is in the context of the purchaser picking a product and a logo to combine into a common image. *See* Knight, 9:30-10:67. Note that the selection is made by a *purchaser* by *clicking* on one of several keys (154a-154e) shown in the web page of Figure 3E of Knight. A user *manually* selecting a color by clicking on an item of a web page, as disclosed by Knight, does *not* teach or suggest sending the identity of the corresponding color, ascertained by mapping a color image data signal produced from a scan to a defined color space.

The teaching in Knight of a purchaser manually selecting a color and communicating the manual selection of that color to a website would not have motivated a person of ordinary skill in the art to send the mapped color described in Kohler to a target output device. Kohler teaches a system that attempts to achieve consistent output among different types of output devices. On the other hand, Knight's teachings are completely different, and relate to user selection of color in making an online purchase. Objectively, a person of ordinary skill in the art would not have

been motivated to combine the disparate teachings of Kohler and Knight to achieve the claimed subject matter, as there clearly did not exist any teaching of any desirability to incorporate the subject matter of Knight (manual selection by a user in an online purchase) into Kohler. *See In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the *desirability* of the modification.”) (emphasis added).

In fact, the only basis for making the proposed combination of Kohler and Knight is impermissible hindsight benefiting from the disclosure of the present invention. *See In re Fritch*, 972 F.2d at 1266 (“It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious”); *see also, In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

Ignoring the *context* of the teachings of Kohler and Knight, the Office Action continues to assert that Kohler “performs determining an identity of a color and sending the identity of that color over a network to a website,” with the Office Action citing specifically to pages 2 and 3 of the previous Office Action (dated February 22, 2006). Pages 2 and 3 of the 2/22/2006 Office Action cited column 4, lines 61-65, of Kohler as teaching the sending of the identity of the corresponding color over a network to a website. The cited passage in column 4 of Kohler refers to a computer system outputting images to a variety of other destinations, such as a local area network or the worldwide web through a network interface, where the images are output through devices such as printers or displays. On the other hand, Knight refers to a purchaser clicking on one of several keys to manually select a color on a web page. The proposed combination of completely un-related elements of Kohler and Knight as performed by the Office Action is clearly based on impermissible hindsight, since a person of ordinary skill in the art would clearly not have been motivated to combine Kohler and Knight based on the *actual* teachings of Kohler and Knight. Without the benefit of the disclosure of the present invention, a person of ordinary skill in the art clearly would not have been led to combine the completely un-related reference teachings in the manner proposed by the Office Action.

It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 1 for at least this reason.

A further defect in the *prima facie* case of obviousness against claim 1 is that, even if the Kohler and Knight can be properly combined, that hypothetical combination does not teach or suggest all elements of claim 1. Note that claim 1 recites sending *the* identity of the corresponding color over a network to a website. Claim 1 does not recite sending an identity of the corresponding color over a network to a website. The element “the identity” refers to the identity of the corresponding color that is determined in the determining act of claim 1, where “the corresponding color” refers to the ascertained corresponding color based on mapping the color image data signal to a defined color space, and where the color image data signal is produced based on scanning an object. In other words, “the identity of the corresponding color” recited in claim 1 is *not* any identity of a color – claim 1 is very specific that the identity of the corresponding color is related to a color image data signal produced by scanning an object. Therefore, the citation of Knight as disclosing or suggesting the sending element of claim 1 is clearly erroneous, as Knight merely teaches that a user can click on a color to select a color for a product.

The Office Action conceded that Kohler fails to disclose the last clause of claim 1. As noted above, Knight also fails to disclose or suggest the sending act of claim 1. Therefore, the hypothetical combination of Kohler and Knight fails to disclose or suggest the sending of the identity of *the* corresponding color (ascertained from mapping the color image data signal produced by scanning an object to a defined color space) over a network to a shopping website for purchasing a product having the corresponding color. The *prima facie* case of obviousness is therefore defective for this additional reason.

Claims dependent from claim 1 are allowable for at least the same reasons. Moreover, in view of the allowability of claim 1 over Kohler and Knight, it is respectfully submitted that the rejections (including the obviousness rejections) of claims dependent from claim 1 have been overcome.

CLAIMS 14 & 28

Independent claim 14 was rejected as being obvious over Kohler and Ringland. It is respectfully submitted that a *prima facie* case of obviousness has also not been established with respect to claim 14 for at least the following two reasons: (1) no motivation or suggestion existed to combine the teachings of Kohler and Ringland; and (2) the hypothetical combination of Kohler and Ringland does not teach or suggest all elements of the claim.

The Office Action conceded that Kohler fails to disclose: in response to user selection, select a color region of the color image data signal representative of the object; determine a dominant color from a plurality of colors in the selected color region; present the identity of the corresponding color to a user; and that the mapped portion of the color image signal corresponds to the dominant color. 8/4/2006 Office Action at 17. The Office Action relied upon Ringland as disclosing the claimed features missing from Kohler. *Id.*

The Office Action cited to various passages in columns 19 and 20 of Ringland as disclosing these claimed features. *Id.* The cited passages of Ringland describe a paint matching window that contains a “Match Paint” button 702 for finding paints 706 that match the colors of any sample that has been marked for later use. The user is shown a color swath for each matching paint, along with the paint name, the manufacturer’s number, and the page number in the manufacturer’s book. These cited passages of Ringland refer to matching paints (note plural sense) to plural colors (note plural sense) of a sample. There is no indication or suggestion here, or anywhere else in Ringland, of a computer determining a *dominant* color within a selected color region of a color image data signal that represents an object that has been scanned by a scanning apparatus, and mapping a portion of the color image data signal corresponding to the *dominant* color to the defined color space.

Clearly, neither Kohler nor Ringland even remotely suggest the determining a dominant color from a plurality of colors in a selected color region and mapping a portion of the color image data signal corresponding to the dominant color to the defined color space to ascertain an identity of the corresponding color. The Office Action argued that “while the system taught by Ringland can match more than one paint color, each color is matched individually.” 8/4/2006 Office Action at 4. The Office Action further noted that when the user presses the “Match Paint” button, the color sample or samples are matched. *Id.* The Office Action further stated that “by

selecting 'Coord Paint', a common hue is matched which may have a different level of saturation" *Id.* The Office Action thus concluded that "the dominant color is determined from a plurality of possible colors in a color region, said dominant color being the matching or coordinating color" (*id.* at 4-5), and that "[e]ach color is matched individually to a single color in a color region" (*id.* at 5).

The assertion in the Office Action that matching a color individually to a single color in a color region (see 8/4/2006 Office Action at 5) corresponds to the step of determining a dominant color, as recited in claim 14, is clearly erroneous. Claim 14 expressly recites "determine a dominant color from *a plurality of colors* in the selected color region." Matching one color individually to a single color in a color region cannot possibly satisfy determining a dominant color *from a plurality of colors* in a selected color region, as recited in the claim. Therefore, the teaching of Ringland relied upon by the Office Action in making the obviousness rejection does not support the obviousness rejection. The obviousness rejection is clearly defective, and therefore, a *prima facie* case of obviousness has not been established since the hypothetical combination of Kohler and Ringland does not teach or suggest all elements of claim 14.

Moreover, it is respectfully submitted that there clearly did not exist any motivation or suggestion to combine the teachings of Kohler and Ringland. The cited portions of Ringland refer to matching paints to plural colors of a sample. On the other hand, Kohler relates to mapping a color point in a first color space of a first output device to a different color space for another output device. A person of ordinary skill in the art looking to the teachings of Kohler and Ringland clearly would not have been motivated to combine the disparate teachings of references to achieve the claimed invention. The *prima facie* case of obviousness is defective for this additional reason.

Amended independent claim 28 is allowable over Kohler and Ringland for similar reasons as claim 14.

Claims dependent from claims 14 and 28 are allowable for at least the same reasons. Moreover, in view of the allowability of base claims 14 and 28 over Kohler and Ringland, it is respectfully submitted that the obviousness rejections of dependent claims of claims 14 and 28 over Kohler, Ringland, and other references have also been overcome.

CLAIM 26

Independent claim 26 was rejected as being obvious over Kohler and Lee. The Office Action conceded that Kohler does not disclose the following elements: an object having a texture; processing the color image data to remove influence of the texture, the processing producing a de-texturized color image data; and mapping the de-texturized color image data to determine a corresponding color in a defined color space. 8/4/2006 Office Action at 25. Again, the Office Action has conceded that Kohler fails to disclose a significant portion of the claimed subject matter. In attempting to remedy this defect of Kohler, the Office Action relied upon Lee as disclosing the missing claimed subject matter.

Again, a *prima facie* case of obviousness has not been established. Lee does mention that an object of interest can have texture, and that the texture of the object of interest can be removed. Lee, 6:58-61. However, in Lee, the goal of removing the texture of an object is for the purpose of creating a mask that identifies the size, shape, and location of the object of interest. Lee, 6:54-56. There is absolutely no suggestion whatsoever of processing a *color* image data to remove influence of texture, and producing a de-texturized *color* image data, and mapping the de-texturized *color* image data to determine a corresponding color in a defined color space, as recited in claim 26. In fact, Lee does not even use the word “color” in its disclosure.

Apparently ignoring the specific teachings of Kohler and Lee, the Office Action stated that “[a]pplying the teachings of Lee to the primary reference of Kohler would result in de-texturizing the color image data taught by Kohler.” 8/4/2006 Office Action at 5-6. There is absolutely no teaching or suggestion of any desirability to incorporate the teachings regarding de-texturizing to the teachings of Kohler, which relate to sending an image for output to an output device such as a printer. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the *desirability* of the modification.” *In re Fritch*, 972 F.2d at 1266 (emphasis added). There is absolutely no suggestion by Lee or by Kohler that de-texturizing would be desirable in the context of the system of Kohler regarding outputting an image to an output device, such as to print.

In view of the foregoing, it is respectfully submitted that the hypothetical combination of Kohler and Lee clearly fails to teach or suggest all elements of claim 26.

Moreover, there clearly did not exist any suggestion to incorporate the de-texturing feature of Lee into Kohler. As noted above, Kohler relates to mapping a color in one color space to a color in a different color space associated with corresponding different output devices. The mapping is performed by mapping a color point in one space to a different color point in another space. The issue of texturing clearly is not present in Kohler, and clearly there did not exist any suggestion of any desirability to perform de-texturing. In view of this, it is respectfully submitted that no motivation or suggestion existed to combine the teachings of Kohler and Lee to achieve the claimed subject matter.

Therefore, a *prima facie* case of obviousness has clearly not been established with respect to claim 26 and its dependent claims. In view of the allowability of claim 26 over Kohler and Lee, it is respectfully submitted that the obviousness rejection of dependent claim 27 over Kohler, Lee, and Knight has also been overcome.

In view of the foregoing, allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (10004872-1).

Respectfully submitted,

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